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OFFICE OF PETITIONS

In re Application of :
Dustin Carr, Ho Bun Chan and :
Alex Tran :
Application No. 10/743,253 :
Filed: December 22, 2003 :
Title: OPTICAL SUBSTANCE ANALYZER :
Attorney Docket No. Carr 8-4-5 :

DECISION REFUSING STATUS
UNDER 37 C.F.R. § 1.47(a)

This is a decision on the "PETITION UNDER 37 CFR 1.47(a)," filed May 26, 2004.

The petition is **DISMISSED**.

Rule 47 applicants are given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. § 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. § 1.136(a).

The above-identified application was filed on December 22, 2003, with an unexecuted declaration, missing the basic statutory filing fee and with additional claim fees due. Accordingly, on April 5, 2004, applicants were mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted (Notice)," requiring the missing items, including an executed oath or declaration and a surcharge for its late filing. This Notice set a two-month period for reply with extensions of time obtainable under § 1.136(a).

In response, applicants timely filed the instant petition; payment of the missing fees; the late surcharge under § 1.16(e); along with a declaration executed by inventors Chan and Tran on behalf of themselves and on behalf of non-signing inventor Carr. Applicants assert that status under § 1.47(a) is proper because joint inventor Carr is uncooperative.

A grantable petition under 37 C.F.R. § 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or found, after diligent effort, or refuses to sign the oath or declaration

after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. The instant petition does not satisfy requirement (1).

Petitioner has not shown that inventor Carr has refused to join in the application. Before a refusal can be alleged, applicants must demonstrate that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor. See MPEP 409.03(d). The evidence only indicates that attempts were made to present the declaration and assignment papers to inventor Carr. The petition includes a statement by patent attorney Yuri Gruzdkov that we have provided all inventors with a copy of the application as filed on December 22, 2003. However, this statement is inconsistent with the evidence submitted reflecting submission of only the declaration and assignment papers.

Further, by email communication dated December 17, 2003, inventor Carr provided his address. Yet, the evidence submitted indicates that all attempts to contact inventor Carr by mail were addressed to a different address, his work address. So even if the mailings included the application as filed, rule 47 applicants did not send the papers to the address where inventor Carr indicated that he customarily receives mail.

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Thus, on renewed petition, applicants must establish that the entire application package, including specification, claims and drawings, was presented to non-signing inventor Carr and he subsequently refused to sign. If they have not already been sent, a copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the inventor is represented by counsel, to the address of the non-signing inventor's attorney.

Furthermore, unless rule 47 applicants can establish inventor Carr's actual receipt of the application papers at Sandia National Laboratories, the application papers should be sent to the address provided by inventor Carr, his home address, rather than to a large quasi-governmental agency. Otherwise, a showing of refusal by conduct, in not responding, is not adequately supported.

Further correspondence with respect to this matter should be addressed as follows:

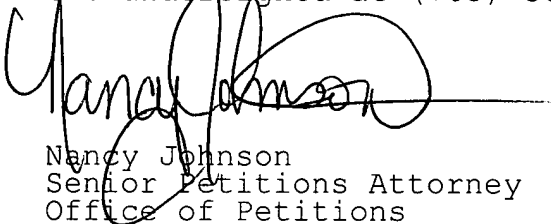
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By FAX: (703) 872-9306
ATTN: NANCY JOHNSON
SENIOR PETITIONS ATTORNEY

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Telephone inquiries specific to this matter should be directed to the undersigned at (703) 305-0309.



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